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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/622,001	09/22/2000	Yasutaka Ishii	3273-0121P	5966

2292 7590 05/07/2002

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EXAMINER

SOLOLA, TAOFIQ A

ART UNIT	PAPER NUMBER
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1626

DATE MAILED: 05/07/2002

91

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/622,001

Applicant(s)
Ishii et al.

Examiner
Taofiq A. Solola

Art Unit
1626



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Mar 25, 2002
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above, claim(s) 3-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, and 21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☒ All b) ☐ Some* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 20) ☐ Other: _____

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Claims 1-21 are pending in this application.

Claims 3-20 are drawn to non-elected inventions.

Restriction Requirement

The response to the restriction requirement of 1/24/02, Paper No. 6, is hereby acknowledged. However, applicant failed to select a group for Examiner as required. Applicant argues that the groups are so related so as to form a single inventive concept. Applicant cited examples of specific compounds and identified them by their respective functions. This is not persuasive because not all the claims are addressed. Also, the explanation is not clear and confusing. Therefore, group I, claims 1-2 and 21, has been selected for examination.

The restriction is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-2 and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite in that it fails to point out what is included or excluded by the claim language. This claim is an omnibus type claim.

For example, the term "organic compound," "compound capable of forming a stable radical," "oxygen-atom-containing compounds" render the claims indefinite. Under US patent

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practice, the product of a process of making determines the class(s) and subclass(s) of the process. Such class(s) and subclass(s) must be searched so as to determine novelty. The definitions of organic compounds and the substituents in the specification cover so many compounds as to make any selection impossible. However, searching the few specific examples disclosed in the specification would result in incomplete search of the claims. In addition, the claims are not classifiable, and therefore, are not searchable. The staff of Science and Technology Information Center at USPTO attempted to search claims 1-4 and 14-21, but could not perform a complete search of the claims. The level of technology is such that the claims cannot be satisfactorily searched at this time.

Applicant must narrow the scope of the claims, and list specific compounds (not functional groups on the compounds) represented by the substituents (e.g. Ra to Rq, R1-R2). Also, specific reactants must be listed in claim 1.

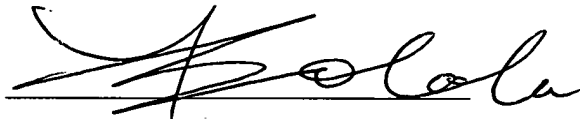
Telephone Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Taofiq A. Solola whose telephone number is (703) 308-4690. The examiner is on flexible work schedule and the best days to get him are Mondays, Wednesdays and Fridays.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Joseph McKane, can be reached on (703) 308-4537. The fax phone number for this Group is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.

A handwritten signature in black ink, appearing to read 'Taofiq A. Solola', written over a horizontal line.

Taofiq A. Solola, Ph.D.

Primary Examiner

Group 1626

May 3, 2002